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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/733,628	12/11/2003	Russell Bonaventura	LEAP:127US	1669

7590 06/14/2005

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EXAMINER

LAVARIAS, ARNEL C

ART UNIT	PAPER NUMBER
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2872

DATE MAILED: 06/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/733,628	<b>Applicant(s)</b> BONAVENTURA ET AL.	
	<b>Examiner</b> Arnel C. Lavarias	<b>Art Unit</b> 2872	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 4/7/04, 12/11/03.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 December 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>4/7/04</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Drawings***

1. The drawings were received on 12/11/03. These drawings are objected to for the following reason(s) as set forth below.
2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference characters "26" and "28" have both been used to designate the upper stage (See Figure 6). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

3. The attempt to incorporate subject matter into this application by reference to "Interchangeable Microscope Slide drive Assembly", "Microscope Stage Apparatus and Movement Means", and "Interchangeable Microscope Fine Adjustment Means" (See

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Paragraph 0018 in the specification of the disclosure) is ineffective because the reference documents are not clearly identified as required by 37 CFR 1.57(b)(2).

4. The incorporation by reference will not be effective until correction is made to comply with 37 CFR 1.57(b), (c), or (d). If the incorporated material is relied upon to meet any outstanding objection, rejection, or other requirement imposed by the Office, the correction must be made within any time period set by the Office for responding to the objection, rejection, or other requirement for the incorporation to be effective. Compliance will not be held in abeyance with respect to responding to the objection, rejection, or other requirement for the incorporation to be effective. In no case may the correction be made later than the close of prosecution as defined in 37 CFR 1.114(b), or abandonment of the application, whichever occurs earlier.

Any correction inserting material by amendment that was previously incorporated by reference must be accompanied by a statement that the material being inserted is the material incorporated by reference and the amendment contains no new matter. 37 CFR 1.57(f).

5. The disclosure is objected to because of the following informalities:

Paragraph 0013- Delete 'a'.

Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 9-10, 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Kapitza et al. (U.S. Patent No. 5781338).

Kapitza et al. discloses a microscope stage (See Figures 1-3) comprising an upper stage comprising a first color, e.g. black as by black lacquer paint (See col. 1, lines 6-24), and including a recess therein (See for example 7 in Figure 1); and a contrasting stage insert comprising a second color (e.g. brightly colored or matte white) different from the first color and configured for complementarily receipt within the recess (See 12 in Figure 1; col. 3, lines 25-30). Kapitza et al. additionally disclose the contrasting stage insert being illuminable by LED's (See 33a, 33b in Figures 2-3; col. 3, line 66-col. 4, line 15); the contrasting stage insert comprising a portion of the upper stage background (See 7, 11, 12 in Figure 1); and a specimen (See col. 1, lines 6-24).

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1, 7-8, 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kapitza et al. in view of Kawasaki (U.S. Patent No. 6040940).

Kapitza et al. discloses the invention as set forth above in Claims 1, 9, except for the contrasting stage insert being removable. However, it is noted that the contrasting stage insert (i.e. brightly colored lacquer) of Kapitza et al. is provided on the base portion of the microscope stage, between the base portion and a protective glass plate (See 11, 12, 7 of Figure 1 of Kapitza et al.). It is reasonable and well known in the art to instead provide such a layer on the glass plate or to forgo such a layer (See for example Figure 3 of Kapitza et al.) and instead have the glass plate have an inherent color, which may or may not be different from the microscope stage (in the instant case, the glass plate is transparent). Since the glass plate of Kapitza et al. is also inserted into the recess of the microscope stage, one of ordinary skill would also be able to remove such a plate, in cases where replacement of this plate is necessary. For example, Kawasaki teaches a conventional reflecting fluorescence microscope (See Figures 4-6, 8-10, 12), wherein the microscope stage (See for example 13 in Figure 10) may include a stage insert (See 26, 35, 36), such as a colored glass (e.g. a neutral density filtering glass), which is received in and removable from a recess in the stage. Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have the contrasting stage insert be removable, as taught by Kawasaki, in the stage of Kapitza et al., to allow for quick removal and replacement of the insert, during operation of the microscope,

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particular during times where the insert becomes damaged or a different insert is required.

10. Claims 2-3, 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kapitza et al. in view of Kawasaki as applied to Claims 1, 9 above, and further in view of Brock (U.S. Patent No. 5071241).

Kapitza et al. in view of Kawasaki discloses the invention as set forth above in Claims 1, 9, except for the contrasting stage insert comprising alignment means, such as a recess pin and a contrasting stage insert bore, for aligning the contrast stage insert within the recess. However, the use of such pins and corresponding bores for alignment purposes is well known and conventional in the art. For example, Brock teaches a conventional microscope system with a camera attachment system (See for example Figures 1-2), wherein an attachment plate (See 106 in Figures 1-2) is aligned and mounted onto the microscope stage (See 22 in Figures 1-2) via the use of a pin in the form of a screw (See 112 in Figure 1) inserted into a bore in the form of a hole in the stage (See dotted lines near 112 in Figure 1). Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have the contrasting stage insert comprise alignment means, such as a recess pin and a contrasting stage insert bore, for aligning the contrast stage insert within the recess, as taught by Brock, in the stage of Kapitza et al. in view of Kawasaki, for the purpose of preventing movement of the insert during use.

11. Claims 4-6, 11-12, 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kapitza et al. in view of Kawasaki as applied to Claims 1, 9 above, and further in view of Zimmermann et al. (U.S. Patent Application Publication US 2004/0085629 A1).

Kapitza et al. in view of Kawasaki discloses the invention as set forth above in Claims 1, 9, except for the contrasting stage insert including releasable fastening means, such as adhesive film, magnets/magnetic surfaces or springed detents. However, the use of such releasable fastening means such as adhesive films, magnets/magnetic surfaces and springed detents to allow for easy removal and attachment of items is well known and conventional in the art. For example, Zimmermann et al. teaches a conventional optical system, such as a microscope, wherein various optical elements may be attached and removed quickly and easily via the use of detents (See Figure 4) or pairs of identical magnets/magnetic surfaces (See Figures 1-2) within the mounting structures of the optical elements. Although the use of adhesive films is not specifically taught by Zimmermann et al., such adhesive films, such as double-sided tape, is well known in the art for use in attachment applications. Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have the contrasting stage insert include releasable fastening means, such as adhesive films, magnets/magnetic surfaces or springed detents, as taught by Zimmermann et al., in the stage of Kapitza et al. in view of Kawasaki, to provide for precise and accurate positioning of the insert, while allowing for quick removal and replacement of the insert when needed.

12. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kapitza et al. in view of Sattler (U.S. Patent No. 4906083).

Kapitza et al. discloses a device for providing contrast between a microscope stage and a specimen (See Figures 1-3; col. 1, lines 6-24), comprising a microscope stage (See for example 7 in Figure 1) comprising a contrasting stage insert (See 12 in Figure 1; col.



3, lines 25-30) having a first color (e.g. brightly colored or matte white); and a specimen (See col. 1, lines 6-24). Kapitza et al. does not explicitly disclose the specimen having a second color being different from the first color of the contrasting stage insert. However, it is well known in the art that many of the specimens examined by microscopes will have some color, which may be different from that of the stage (e.g. black) and/or a stage insert (e.g. transparent or matte white). For example, Sattler teaches a conventional microscope for examining gemstones (See Abstract; Figures 1-2), wherein the gemstones (i.e. the specimen) may have a color that is different from the microscope stage (See 10 in Figures 1-2; col. 8, lines 3-28) or the sample holder (See 54 in Figures 1-2; col. 4, line 60-col. 6, line 2) on which the sample is placed. Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have the specimen have a second color be different from the first color of the contrasting stage insert, as taught by Sattler, in the stage of Kapitza et al., to allow for higher contrast, while maintaining or reproducing accurate and true color of the specimen, during viewing of the specimen.

13. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kapitza et al. in view of Sattler as applied to Claim 17 above, and further in view of Kawasaki.

Kapitza et al. in view of Sattler discloses the invention as set forth above in Claim 17, except for the contrasting stage insert being releasably secured to the microscope stage. However, it is noted that the contrasting stage insert (i.e. brightly colored lacquer) of Kapitza et al. is provided on the base portion of the microscope stage, between the base portion and a protective glass plate (See 11, 12, 7 of Figure 1 of Kapitza et al.). It is

reasonable and well known in the art to instead provide such a layer on the glass plate or to forgo such a layer (See for example Figure 3 of Kapitza et al.) and instead have the glass plate have an inherent color, which may or may not be different from the microscope stage (in the instant case, the glass plate is transparent). Since the glass plate of Kapitza et al. is also inserted into the recess of the microscope stage, one of ordinary skill would also be able to remove such a plate, in cases where replacement of this plate is necessary. For example, Kawasaki teaches a conventional reflecting fluorescence microscope (See Figures 4-6, 8-10, 12), wherein the microscope stage (See for example 13 in Figure 10) may include a stage insert (See 26, 35, 36), such as a colored glass (e.g. a neutral density filtering glass), which is received in and removable from a recess in the stage. Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have the contrasting stage insert be releasably secured to the microscope stage, as taught by Kawasaki, in the stage of Kapitza et al. in view of Sattler, to allow for quick removal and replacement of the insert, during operation of the microscope, particular during times where the insert becomes damaged or a different insert is required.

14. Claims 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kapitza et al. in view of Sattler as applied to Claim 17 above, and further in view of Zimmermann et al.

Kapitza et al. in view of Sattler discloses the invention as set forth above in Claim 17, except for the contrasting stage insert including releasable fastening means, such as adhesive film, magnets/magnetic surfaces or springed detents. However, the use of such

releasable fastening means such as adhesive films, magnets/magnetic surfaces and springed detents to allow for easy removal and attachment of items is well known and conventional in the art. For example, Zimmermann et al. teaches a conventional optical system, such as a microscope, wherein various optical elements may be attached and removed quickly and easily via the use of detents (See Figure 4) or pairs of identical magnets/magnetic surfaces (See Figures 1-2) within the mounting structures of the optical elements. Although the use of adhesive films is not specifically taught by Zimmermann et al., such adhesive films, such as double-sided tape, is well known in the art for use in attachment applications. Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have the contrasting stage insert include releasable fastening means, such as adhesive films, magnets/magnetic surfaces or springed detents, as taught by Zimmermann et al., in the stage of Kapitza et al. in view of Sattler, to provide for precise and accurate positioning of the insert, while allowing for quick removal and replacement of the insert when needed.

### ***Conclusion***

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arnel C. Lavarias whose telephone number is 571-272-2315. The examiner can normally be reached on M-F 9:30 AM - 6 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew Dunn can be reached on 571-272-2312. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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6/13/05